

REMARKS

This responds to the Office Action mailed on October 21, 2004. Claim 35-38 are amended. No claims are canceled or added. As a result, claims 1-38 remain pending in this application.

Double Patenting Rejection

Claims 35 and 36 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 36 and 37 of U.S. Application Serial No. 10/025,183. Applicant respectfully traverses.

The present form of the cited claims 36 and 37 from U.S. Application Serial No. 10/025,183 (“the co-pending application”) are reproduced below, for the Examiner’s convenience and comparison to claims 35 and 36 of the instant application:

36. (Original) A method comprising:
- receiving a first wireless signal from a near field transmission source;
 - opening a channel to communicate using a wireless far field link;
 - receiving data on the channel;
 - closing the channel after a predetermined period;
 - storing the data in memory of an implantable medical device; and
 - operating the implantable medical device based on the memory.
37. (Original) The method of claim 36, wherein receiving a first wireless signal includes receiving an inductively coupled signal.

(Claims 36 and 37 from 10/025,183 as pending on November 11, 2004.) Claim 35 of the present patent application has been amended to more particularly point out and distinctly claim aspects of the present device and to correct certain formalities.

The Examiner has the burden to show that (1) the inventions claimed (2) are not patentably distinct and (3) are based on a *prima facie* showing of obviousness. This analysis must be based on what the claim defines and not attempting to use the other claim language itself as a prior art reference, as required by the Federal Circuit:

[I]t is important to bear in mind that comparison can be made only with what invention is *claimed* in the earlier patent, paying careful attention to the rules of claim interpretation

to determine what invention a claim *defines* and not looking to the claim language for anything that happens to be mentioned in it as though it were a prior art reference. ... [W]hat is claimed is what is *defined by the claim taken as a whole*, every claim limitation ... being material. *General Foods Corp. V. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 23 USPQ 2d, 1839, 1845 (Fed. Cir. 1992). (emphasis in original.)

Applicant respectfully submits that the Office Action has not made a *prima facie* case of judicially-created obviousness-type double patenting. Claims 36 and 37 from the co-pending patent application appear to be directed toward using a near-field transmission source to activate a far-field communication link between an implantable medical device and an external device. By contrast, the present claims 35 and 36 are directed toward using a first external telemetry interface device as an intermediary between an implantable medical device and a second external device. Applicant respectfully submits that using an intermediary external device to assist in communication between an implantable medical device and a remote second external device is not in any way obvious over using a near-field transmission source to activate a far-field communication link between an implantable medical device and an external device.

For example, nothing in the cited claims of the co-pending application appears to recite a data flow to or from the implantable device, through an intermediary device, and on to or from a remote external device. The cited claims of the present patent application, however, recite or incorporate an intermediary device that processes the first communication from a first transceiver (which is configured to be communicatively coupled to the implantable medical device) and providing a resulting second communication to a second transceiver (which is configured to be communicatively coupled to the remote external transceiver). By contrast, the co-pending application only recites using the near-field transmission signal to activate a far field communication link between an implantable medical device and an external device—nothing in the cited claims of the co-pending application appears to relate to using an intermediary device to relay data communicated from an implantable medical device to a remote external device.

Accordingly, because the rejected claims are not *prima facie* obvious over the cited claims of the co-pending patent application, Applicant respectfully requests withdrawal of this basis of rejection of these claims.

Allowable Subject Matter

Applicant acknowledges the allowance of claims 1-34.

Claims 37 and 38 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, because Applicant believes that the rejected base claim is allowable, for the reasons given above, Applicant respectfully requests withdrawal of this basis of objection to these dependent claims 37 and 38.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6951 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

JEFFREY A. VON ARX ET AL.

By their Representatives,

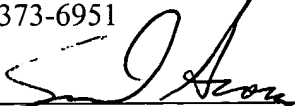
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

P.O. Box 2938

Minneapolis, MN 55402

(612) 373-6951

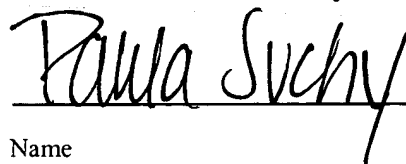
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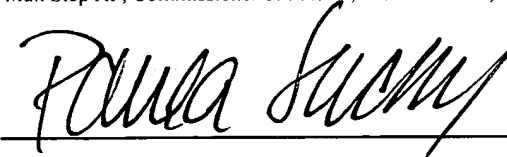
By 

Suneel Arora

Reg. No. 42,267

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 12 day of November, 2004.


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